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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,476	11/08/2001	Keisuke Tanaka	2091-0247P	5608

7590 03/04/2008

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EXAMINER	
MILIA, MARK R	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
03/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/986,476	TANAKA, KEISUKE	
	Examiner	Art Unit	
	Mark R. Milia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,7-9,11,14-16,18 and 20-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,7-9,11,14-16,18 and 20-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/07 has been entered. Currently, claims 1-2, 4, 7-9, 11, 14-16, 18, and 20-23 are pending.

Response to Arguments

2. Applicant's arguments filed 12/17/07 have been fully considered but they are not persuasive.

Applicant asserts that the combination of Chui (US 6,657,702) and Fredlund (US 6,154,295) fails to disclose the limitations set forth in claims 1, 8, 15, and 22, specifically that Fredlund does not disclose a server adapted to extend the predetermined storage period for the image data for which the order was placed. The examiner respectfully disagrees as the combination of Chui and Fredlund does disclose all the limitations set forth in claims 1, 8, 15, and 22. Particularly, Fredlund discloses that processed film is

scanned to produce a digital image file (column 3 lines 24-26) and also discloses that the photofinisher may not make any prints until the customer places an order (see column 4 lines 39-41) and a specified storage period is set, if no order is placed during the time period then the file is automatically deleted (see column 4 lines 43-46). The computer **26** is responsible for control over all of these processes. Fredlund further discloses that the storage time period can be extended by a customer by calling a 1-800 number and using a touch tone telephone, without requiring additional personnel (see column 3 lines 41-57 and column 4 lines 50-55). Even though the customer initializes the extension of time, the computer **26** (server) actually changes the time period. Further, Chui discloses a system in which an on-line interaction between a customer computer terminal and a server, via a network, is utilized to order digital image prints that have been transferred to the server by a customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the setting of a storage period and the ability to extend the storage period because it would be beneficial for both the customer and the service provider. It is beneficial to a customer because it allows the user more time to decide when, and if the user desires prints of the digital images. It is beneficial to the service provider because if a user does not place an order within the predetermined time period that the digital image files are deleted, thus freeing up memory space that the service provider can use for another customer. Even further, Chui and Fredlund are very much combinable because both disclose systems for ordering prints of digital images.

The applicant also asserts that the server automatically extends the storage time without any action from a user. The examiner agrees that neither Chui nor Fredlund disclose such a feature but the current claim language does not support such an assertion as the claims only state that the server extends the predetermined storage period without any statement that it is performed automatically and/or without user intervention. Therefore, Chui and Fredlund are still seen to disclose the claimed invention.

3. Therefore, the rejection of claims 1-2, 4, 7-9, 11, 14-16, 18, and 20-22, as set forth in the previous Office Action, is maintained. Newly added claim 23 will be addressed in the following rejection.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2, 4, 7-9, 11, 14-16, 18, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui (US 6657702) in view of Fredlund (US 6154295) and further in view of well known prior art.

Regarding claim 1, Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A

and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly wherein the server is adapted to perform setting a predetermined storage period of the image data, displaying the predetermined storage period on the user terminal, and extending the predetermined storage period for the image data for which the order was placed.

Fredlund discloses wherein the server is adapted to perform setting a predetermined storage period of the image data and extending the predetermined storage period for the image data for which the order was placed (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-55, reference states that a customer can call the photo processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also

states that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted).

Chui and Fredlund also do not disclose expressly displaying the predetermined storage period on the user terminal. However, it is well known in the art (Official Notice) to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location (server) and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the calling of a 1-800 number to extend a storage period with the extending of the storage period through the interface/web page of the photo processing location.

Therefore it would have been obvious to modify the server of Chui to set the predetermined storage period, such as Fredlund discloses, and display said storage period on the user terminal because Chui discloses a display that allows a user to set a plurality of options for selecting and printing digital files and it would provide a user with greater control over the transmitted images, especially the period of time in which the image will be available to the user, which would provide the user with more time to decide when, and if, the user desires the digital images to be printed.

Chui & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

Therefore, it would have been obvious to combine well known prior art and Fredlund with Chui to obtain the invention as specified in claims 1.

Regarding claim 8, Chui discloses a print ordering system comprising a server adapted to receive an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), wherein the server is adapted to store the image data transferred thereto regardless of whether or not the order is placed at the time of transfer of the image data, and receives the order for the print regarding the image data stored therein after the image data are stored therein in the case where the order was not placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47), and wherein the server is further adapted to display on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly wherein the server sets a predetermined storage period of the image data, to display the predetermined storage period on the user terminal, and to extend the predetermined storage period for the image data for which the order was placed.

Fredlund discloses wherein the server sets a predetermined storage period of the image data and to extend the predetermined storage period for the image data for which the order was placed (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-55, reference states that a customer can call the photo processing lab and have the

storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also states that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted).

Chui and Fredlund also do not disclose expressly displaying the predetermined storage period on the user terminal. However, it is well known in the art (Official Notice) to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location (server) and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the calling of a 1-800 number to extend a storage period with the extending of the storage period through the interface/web page of the photo processing location.

Therefore it would have been obvious to modify the server of Chui to set the predetermined storage period, such as Fredlund discloses, and display said storage period on the user terminal because Chui discloses a display that allows a user to set a plurality of options for selecting and printing digital files and it would provide a user with greater control over the transmitted images, especially the period of time in which the image will be available to the user, which would provide the user with more time to decide when, and if, the user desires the digital images to be printed.

Chui & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

Therefore, it would have been obvious to combine well known prior art and Fredlund with Chui to obtain the invention as specified in claims 8.

Regarding claim 15, Chui discloses a computer-readable recording medium storing a program to cause a computer to execute a print ordering method used in a print ordering system, the print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the program comprising the procedures of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65 and column 12 lines 39-51) and receiving the order f or the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly the program causing the server to perform setting a predetermined storage period of the image data, displaying the predetermined

storage period on the user terminal, and extending the predetermined storage period for the image data for which the order was placed.

Fredlund discloses wherein the server is adapted to perform setting a predetermined storage period of the image data and extending the predetermined storage period for the image data for which the order was placed (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-55, reference states that a customer can call the photo processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also states that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted).

Chui and Fredlund also do not disclose expressly displaying the predetermined storage period on the user terminal. However, it is well known in the art (Official Notice) to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location (server) and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the calling of a 1-800 number to extend a storage period with the extending of the storage period through the interface/web page of the photo processing location.

Therefore it would have been obvious to modify the server of Chui to set the predetermined storage period, such as Fredlund discloses, and display said storage period on the user terminal because Chui discloses a display that allows a user to set a plurality of options for selecting and printing digital files and it would provide a user with

greater control over the transmitted images, especially the period of time in which the image will be available to the user, which would provide the user with more time to decide when, and if, the user desires the digital images to be printed.

Chui & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

Therefore, it would have been obvious to combine well known prior art and Fredlund with Chui to obtain the invention as specified in claims 15.

Regarding claims 2, 9, and 16, Chui further discloses accepting and storing image data (see column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8 and column 14 lines 47-52) and Fredlund further discloses accepting and storing the image data at the time the order is received if the order is placed at the time the image data are transferred (see abstract, column 3 lines 45-48 and 61-63, column 4 lines 61-65, column 6 lines 23-54, and column 7 lines 15-22, reference shows that the order data and image data are transmitted at the same time to the photo-finisher for output and delivery of prints).

Regarding claims 4, 11, and 18, Fredlund further discloses deleting the image data from the server after the predetermined storage period has elapsed since the image data were put into storage (see column 3 lines 41-54 and column 4 lines 43-47).

Regarding claims 7, 14, and 21, Chui further discloses if the order for the print of the image data is an order for a postcard which has seasonality (see column 4 lines 13-22 and column 23 lines 9-23) and Fredlund further discloses setting the predetermined

storage period of the image data to a period corresponding to a content of a postcard (see column 3 lines 41-54 and column 4 lines 43-47, reference states that the user inputs option data, of which storage time designation is a part of, the storage time can be any amount of time the user desires).

Regarding claim 23, Chui further discloses wherein the server is part of a print order reception center which also includes a database directory and a printer (see Fig. 3A and column 10 lines 41-65).

6. Claims 20 and 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chui (US 6657702) in view of Fredlund (US 6154295) and U.S. Patent No. 6556817 to Souissi et al.

Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52).

Chui does not disclose expressly determining a time of day when communications costs are lower than at other times of day, performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower, writing a predetermined storage period of the image data in tag information of the image data, and the server performing extending the predetermined storage period of the image data for which the order was placed.

Fredlund discloses writing a predetermined storage period of the image data in tag information of the image data and the server performing extending the predetermined storage period for the image data for which the order was placed (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-51, reference states that a customer can call the photo processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also states that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted and that ordering a service may also extend the storage period of the digital files).

Souissi discloses determining a time of day when communications costs are lower than at other times of day and performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower (see column 5 lines 26-32 and column 6 lines 33-57).

Chui, Fredlund, & Souissi are combinable because they are from the same field of endeavor, transmission of data over a network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the writing and extending a storage period of the image data in tag information, as described by Fredlund, and the transferring of image data to a server when communications costs are low, as described by Souissi, and which is well known and commonly used, with the system of Chui.

The suggestion/motivation for doing so would have been to save money and be able to provide lost cost prints to a user by utilizing low cost communications and purging of image files after a certain period of time.

Therefore, it would have been obvious to combine Fredlund and Souissi with Chui to obtain the invention as specified in claim 22.

Regarding claim 20, Chui and Fredlund do not disclose expressly displaying the predetermined storage period on the user terminal. However, it would have been obvious to have the server of Chui display said storage period on the user terminal as Chui discloses a display which allows a user to set a plurality of options for selected and printing digital files and it is well known in the art to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the call of a 1-800 number to extend a storage period with the extending of the storage period through the interface/web page of the photo processing location.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437. The fax phone for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
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